

REMARKS

The status of the claims is as follows. Claims 8-23 and 25 are pending in the application and rejected. Claims 1-7 and 24 are withdrawn. Applicant acknowledges with appreciation the withdrawal of the rejection of Claims 8, 9 and 11 under 35 U.S.C. § 112, first paragraph, and the withdrawal of the rejection of Claims 8 and 25 under 35 U.S.C. § 112, second paragraph. Applicant also acknowledges with appreciation the withdrawal of the rejection of Claims 8-10 and 13-23 under 35 U.S.C. § 102(b). Claims 8-11, 16, 19 and 23 are currently amended. Claims 26-30 are new. Claims 8-11, 13-23 and 25 are rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses the foregoing rejections.

The Claim Amendments Are Supported By The Specification

Claims 8 and 19 are amended to recite “assigning a domain cookie containing a unique identifier to [a] the browser” wherein the browser is associated with a computer to which content is delivered. This step is supported by paragraph [0030] of the specification which states “a primarydomain.com cookie containing a unique identifier for the audience member is assigned to the browser 300.”

The Section 103 Rejections Should Be Withdrawn

Claims 8-10 and 13-23 are rejected under 35 U.S.C. § 103(a) as being anticipated by Merriman et al., U.S. Patent No. 5,948,061 (hereinafter “Merriman”) in view of Paltenghe et al., U.S. Patent No. 6,421,729 (hereinafter “Paltenghe”). Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of Paltenghe, and in further view of do Rosario Botelho et al, U.S. Published Patent

Application No. 2002/0069105 (hereinafter “do Rosario”). Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of Paltenghe, and in further view of Official Notice. Claims 8 and 19 are independent claims, and Claims 9-11, 13-18, 20-23 and 25 depend directly or through intervening claims from one or the other of the two independent claims.

Claim 8 recites, *inter alia*, the steps of (i) “associating the client computer with a segment of client computers based on the profile data,” (ii) “transmitting a segment-targeting cookie, which includes a segment identifier for the segment of client computers, to the client computer,” and (iii) “delivering content to the client computer based on the segment identifier.” Similarly, Claim 19 recites, *inter alia*, the steps of (i) “associating the client computer with a segment of client computers based on the profile data,” (ii) “identifying the segment of client computers with a segment identifier included in a segment-targeting cookie,” (iii) “transmitting the segment-targeting cookie to the client computer,” and (iv) “delivering content to the client computer based on the segment identifier.”

The latest Office Action acknowledges that the foregoing claim limitations are not disclosed in Merriman. See Office Action at 6-7. It is asserted that Paltenghe teaches identifying the segment of audience members with a segment identifier included in a segment-targeting cookie, wherein the segment identifier is separate from said unique identifier, transmitting a segment-targeting cookie to a computer associated with the audience member, and delivering content to the audience member based on the segment identifier. Moreover, it is asserted that it would have been obvious for Merriman to include the foregoing teaching of Paltenghe “to identify the user and their preferences without slowing down the server when only the information in one of the

cookies is needed and to present only the information the user indicated was of interest.” Applicant respectfully disagrees both with the characterization of what Paltenghe teaches and that it would have been obvious to combine such teaching with that of Merriman.

Paltenghe discloses no more than use of a cookie to trigger looking up a user’s stored preferences in a file maintained at a website server. Specifically, Paltenghe states:

For example, a website can request that the user fill out a form detailing the type of information the user prefers to retrieve each time she visits the particular website. The user’s preferences are stored in a file maintained at the website server and linked to a specific cookie transmitted to the user’s PC. The next time that particular PC accesses the website, the cookie transmitted to the website identifies the file containing the user’s preferences so that only the information the user indicated was of interest is provided.

Paltenghe at col. 2, lines 56-65 (emphasis added).

Moreover, the Paltenghe user preference cookie is individualized to each user because “the cookie transmitted to the website identifies the file containing the user’s preferences so that only the information the user indicated was of interest is provided.”

Id. at col. 2, lines 62-65.

Storing user preferences in a file at a website server, and accessing that file using a user preference cookie falls far short of disclosing use of a segment-targeting cookie. Use of a segment-targeting cookie first requires associating a client computer with a segment of client computers, sending a segment-targeting cookie with a segment identifier to the client computer, and sending content to the client computer based on the segment identifier in the segment-targeting cookie. The Examiner’s attention is invited to paragraphs [0034]-[0039] of the present application as support for the foregoing, and more particularly to paragraph [0036], which provides:

A method of delivering targeted content to an audience member based on the segment affinity data is illustrated in Fig. 6. With reference to Fig. 6, an audience member requests a website page in the network of related websites in step 230. The Targeting Engine is notified of the website page request in step 232. Responsive to the audience members request for a website page, in step 234 the Targeting Engine determines whether or not a domain cookie, associated with the requested website page, includes a unique identifier for the audience member. If a unique identifier is not identified, the Targeting Engine will provide a website domain cookie with a unique identifier as described above in connection with Fig. 4. Once a website domain cookie is provided with a unique identifier, in step 236 the Targeting Engine may determine whether or not a segment-targeting cookie is already associated with the audience member in the data warehouse. The segment-targeting cookie may include a segment identifier that indicates the segment(s) to which the audience member belongs. If segment affinity data is stored in the data warehouse for the audience member, then a segment-targeting cookie is created and stored in the audience member computer with the appropriate segment identifier in step 238. In step 240, content may be delivered to the audience member based on the segment identifier in the segment-targeting cookie stored in the audience member computer.

The segment-targeting cookie includes one or more segment identifiers which permit the segment or segments with which a client computer has been associated to be readily identified without the need to identify the client computer associated preferences in a file at a website server. The segment identifier permits large segments of client computers to be targeted with the same content without the need to assess the individualized preferences associated with each client in real time at a website server. Thus, the Paltenghe user preference cookie, which requires accessing preference data at a central server, cannot be equated with the segment-targeting cookie recited in Claims 1 and 19.

Further, even if Paltenghe disclosed segment-targeting cookies, which it does not, there is no basis to combine the teaching of Paltenghe with that of Merriman. In order to establish a prima facie case of obviousness, according to a test predominately used by the courts, three basic criteria must be met. First, there must be some

suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007), the Supreme Court did not dismiss the usefulness of the well established "teaching, suggestion, or motivation" test set forth above, but merely cautioned against its rigid application. The Supreme Court noted that the Federal Circuit "no doubt has applied the test in accord with these principles [set forth in KSR] in many cases." *Id.* at 412, 82 USPQ2d at 1396. Regardless of the precise test used, the Court, quoting *In re Kahn*, cautioned that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 411, 82 USPQ2d at 1396.

The latest Office Action asserts that it would have been obvious to combine the teachings of Merriman with that of Paltenghe based solely on the conclusory statement that Merriman would have wanted to "identify the user and their preferences without slowing down the server when only the information in one of the cookies is needed and to present only the information the user indicated was of interest." See Office Action at 7.

First, Paltenghe does not teach use of a cookie that would not slow down the server. In Paltenghe, the cookie merely triggers the look up of preference information in a file maintained at a website server. Thus, Paltenghe requires a real time lookup of individualized preferences of individual users which will necessarily be a slower process than that attendant to use of the claimed segment-targeting cookie.

Second, the Office Action does not identify any suggestion or motivation that comes from the prior art references themselves for one of ordinary skill in the art to use the Paltenghe user preference cookie in the system of Merriman. The statement in the Office Action that is asserted to justify the combination of prior art references is a conclusory and hindsight statement without support in the references.

In fact, there would be no motivation to combine the teachings of the two prior art references, because Merriman, like Paltenghe, discloses that an ad server may obtain a variety of information about one particular user, and that this information may be stored in a database to be used to select an advertisement to be sent to the user. See Merriman at column 5, lines 50-63 and column 6, lines 6-11. In neither Paltenghe nor Merriman is the user associated with a segment of other users. The method described in both Paltenghe and Merriman determines preferences on an individual user-by-user basis from a database or server, and does not identify a group or segment of client computers by merely receiving a segment identifier in a segment-targeting cookie.

All of the obviousness rejections of Claims 8-23 and 25 depend on the combination of Merriman and Paltenghe. Neither Merriman nor Paltenghe disclose a segment-targeting cookie or its use as claimed. Further, even if Paltenghe disclosed a segment-targeting cookie, there is no basis to combine the teachings of the two prior art references. Paltenghe is merely cumulative of the disclosure in Merriman. In view of

the foregoing, it is respectfully requested that the obviousness rejection of Claims 8-23 and 25 be reconsidered and withdrawn.

Applicant also wishes to point out that various of the dependent Claims 9-18, 20-23 and 25 are patentable for reasons independent of those set forth above. For example, Merriman fails to disclose the steps of determining the absence of a cookie with a unique identifier assigned to a browser and setting a unique identifier in a second domain cookie as a result, which are recited in Claims 9-10. Similarly, Merriman does not disclose the step of modifying a domain cookie as recited in Claim 11. Merriman also fails to disclose the step of defining a segment of client computers by rules that recognize any common affinity between two or more audience members recited in Claim 15. Merriman further fails to disclose the steps of comparing the profile data of a plurality of clients and forming a segment of client computers based on the comparison which are recited in Claims 17 and 21. Accordingly, the rejection of all pending claims, including but not limited to the foregoing specified dependent claims, should be withdrawn.

Should the Office believe anything further is required to place the application in condition for allowance the Examiner is invited to contact Applicant's representative at the telephone number listed below. A two-month extension of time fee is believed to be required for consideration of the present amendment and response. Further, the fee for five (5) additional claims, including one (1) additional independent claim, is believed to be required. The Director is hereby authorized to charge any fee due and any deficiency or credit any overpayment to deposit account number 03-2469. Moreover, if the deposit account contains insufficient funds, the Director is hereby invited to contact the undersigned to arrange payment.

Respectfully submitted,

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